

## **REMARKS/ARGUMENTS**

### **I. Status of the Claims**

Prior to entry of this amendment, claims 1-30 were pending in the application. An office action mailed July 7, 2006 rejected claims 1-30 under the second paragraph of 35 U.S.C. § 112 as being indefinite. The office action also rejected claims 29 and 30 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Finally, the office action rejected claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by Porcari. This amendment amends claims 1, 3, 7, 9, 12, 16 and 27-30 and cancels claims 2, 4-6, 17 and 24 without prejudice or disclaimer. No claims have been added. Hence, after entry of this amendment, claims 1, 3, 7-16, 18-23 and 25-30 will stand pending for examination.

### **II. Interview Summary**

The applicants appreciate the courtesy and professionalism shown by the Examiner during the telephonic interview held between the Examiner and the undersigned on October 24, 2006. During that interview, the undersigned explained why the Porcari reference does not teach or suggest the elements of any pending claim. The Examiner stated that the claims did not clearly point out the features of the invention believed to be novel over the cited reference. Hence, no agreement was reached with respect to the claims.

### **III. Claim Amendments**

Claim 1 has been amended for clarity to replace the term "data processing system" with the term "server system." This claim language is believed to be supported throughout the application, including, merely by way of example, at lines 8-17 on page 3 of the application. Claim 1 has also been amended to recite the following new elements:

"providing, at a client system, a search interface to allow a user to search one or more data sources for potential prior art references;"

“receiving, at the client system, input from a user indicating that the user has identified an electronic document as a prior art reference, the electronic document comprising a set of IDS information for identifying the prior art reference to an official patent office;” and

“in response to the input, transmitting a signal from the client system, the signal indicating that the user has identified the prior art reference;”

The new elements are believed to be supported throughout the application, including in particular at lines 1-24 on page 25 of the application and at lines 16-26 on page 30 of the application. In addition, these elements are supported by the language of prior claim 1, which recited, inter alia, “the signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office, the reference information comprising a set of IDS information that can be used to create an IDS for disclosing the electronic document to an official patent office,” as well as the portions of the specification supporting that claim language.

In addition, claim 1 has been amended to replace the term “second database” with the term “first data source,” to indicate that claim 1 is not limited to searching and loading information merely from databases, but also from other data sources.

Claim 1 has been further amended to recite that the electronic document is accessed “with the server system.” This claim language is believed to be supported throughout the application, including, merely by way of example, at lines 8-17 on page 3 of the application.

Finally, claim 1 has been amended to recite that the IDS information is added to the electronic IDS “via an automated process at the server system” and that the electronic document includes information corresponding to a plurality of fields in the electronic IDS, and wherein adding the IDS information to the electronic IDS comprises extracting the IDS information, via the automated process at the server system, from the electronic document and storing the IDS information, via the automated process and in a format specified by the official patent office, in a corresponding plurality of fields in the electronic IDS.” These amendments are substantially similar to prior claims 2, 5 and 6, and those claims, accordingly, have been canceled.

Claims 3, 16, 18, 28 and 30 have also been amended to selectively replace the term “reference” with the term “identifier” and to selectively replace the term “link” and “linking” with the terms “associate” and “associating” for enhanced clarity. Support for these amendments can be found, inter alia, at lines 32-34 of page 27 (which describes different types of identifiers for cases, such as case numbers, titles, and the like) and lines 30-32 on page 28 of the application (which describes how a single electronic document (i.e., reference) may be associated with one or more patent cases.

Claim 3 also has been amended to correct a typographical error. Claims 7, 9 and 12 have been amended for consistency with claim 1.

Independent claim 16 has been amended in similar fashion to claim 1. Claims 27 and 28, which are directed to systems and correspond to claims 1 and 16, respectively, have been amended. In some respects, the amendments to claims 27 and 28 are similar to the amendments to claims 1 and 16, and are similarly supported.

Claims 29 and 30, which are directed to computer programs and correspond to claims 1 and 16, respectively, likewise have been amended in similar fashion to claims 27 and 28. Claims 29 and 30 have also been amended to recite that the computer program is “stored on a computer readable memory.” Support for this amendment can be found, inter alia, at lines 24-32 on page 7 of the application.

#### IV. Claim Rejections under 35 U.S.C. § 101

Claims 29 and 30 were rejected under § 101 as being directed toward non-statutory subject matter. Those claims have been amended, as noted above, to indicate that the computer programs to which they are directed are stored on a computer readable memory. It is believed that these amendments overcome the rejections under § 101, and reconsideration of those rejections is respectfully requested.

V. Claim Rejections under 35 U.S.C. §112

Claims 1-30 were rejected under § 112, ¶ 2 on a variety of grounds. It is believed that the objections to all claims except claims 3, 16, 18, 28 and 30 have been addressed by the amendments described above, and the rejections of claims 1, 2, 5-15, 19-23, 27 and 29 are believed to have been overcome.

Regarding claims 3, 16, 18, 28 and 30 the office action expresses confusion about the elements “storing a reference link to the electronic document in a reference table,” “storing a reference to each of one or more patent cases in a case number table,” and “linking the reference link in the reference table to each of the references to of the one or more patent cases in the case number table.” Specifically, the office action questions whether the patent cases are applications or prior art references. The applicants submit that the multiple uses of the terms “reference” and “link” are the source of much of this confusion. Accordingly, the term “reference,” as used in conjunction with a patent case in claims 3, has been replaced with the term “identifier,” and the term “link,” where it is used as a verb, has been replaced with the term “associate” in claims 3, 16, 28 and 30. It is submitted that these amendments, coupled with the description provided at page 27, line 23 through page 29, line 9 of the application, is sufficient to allow one skilled in the art to ascertain what is being claimed by claims 3, 16, 18, 28 and 30, and reconsideration of the rejections of those claims is respectfully requested.

If the Examiner still has questions about the meaning of the claims, the Examiner is respectfully requested to call the undersigned before issuing another office action.

VI. Claim Rejections under 35 U.S.C. §102

Claims 1-30 were rejected under § 102 as being anticipated by Porcari. It is respectfully submitted, however, that Porcari fails to teach or suggest the elements of even independent claims 1, 16, and 27-30 and that the rejected claims, therefore, are allowable over Porcari.

For example, in rejecting claim 1, the office action relied entirely on paragraphs 0056-0058 of Porcari. Those paragraphs are reprinted in full below:

[0056] The system optionally includes a system to reference prior art documents and a method hyperlinks to the stored reference. The USPTO requires disclosure of relevant references and current rules require that paper copies of these references be provided with the patent application. The applicant must later forward these paper copies. The present invention anticipates a method of Information Disclosure Statement in XML form that contains hyperlinks to identified documents. The USPTO Patent Full Text and Image Database or the European Patent Office (EPO) esp@ce and the EPO maintain databases using Uniform Resource Locator (URL)-based systems where U.S. Pat. No. 5,579,858 may currently be viewed through the hyperlink: "<http://164.195.100Sect1=PTO1&Sect2=HITOFF&d=PALL&p=1&u=/netah-tml/srchnum.htm&r=1&f=G&l=50&s1>"

[0057] In those instances where there is no internet accessible archive, the present invention contemplates commercial prior art services that will host the document for permanent record storage. Access to the public and patent offices would be through a web interface or URL link as described. One example of a commercial internet-based prior art archive is IP.COM whose web page is [www.ip.com](http://www.ip.com). Linking the prior art eliminates the need to submit paper copies. Only one copy of the reference is needed for use with many applications.

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

This disclosure, however, clearly fails to teach or suggest each element of claim 1. Merely by way of example, claim 1 recites, inter alia, “wherein the electronic document includes information corresponding to a plurality of fields in the electronic IDS, and wherein adding the IDS information to the electronic IDS comprises extracting the IDS information, via the automated process at the server system, from the electronic document and storing the IDS information, via the automated process and in a format specified by the official patent office, in a corresponding plurality of fields in the electronic IDS.” Porcari fails to teach or suggest this element of claim 1.

Porcari merely teaches a system for creating an IDS with hyperlinks to electronic documents. Notably, Porcari does not teach extracting IDS information via an automated process and storing that IDS information (again, via an automated process) in a plurality of fields in an electronic IDS. Even assuming the hyperlink disclosed by Porcari might be construed as information corresponding to a single field (which is reasonably cannot be, since one skilled in the art will appreciate that a hyperlink to a document is not stored within the document itself but instead is an external reference to that document), Porcari still would fail to teach or disclose extracting any information from the document, let alone extracting and storing information corresponding to a plurality of fields. Nor would it be obvious to modify Porcari to operate in the manner of claim 1, since nothing in Porcari teaches the extraction of any information at all from the reference, and it is submitted that the extraction of relevant information from an electronic document is a non-trivial modification from the system disclosed by Porcari.

For at least these reasons, claim 1 is believed to be allowable over Porcari. For at least similar reasons, independent claims 16 and 27-30 are believed to be allowable.

Moreover, Porcari fails to teach or suggest, as recited by claims 1 and 16, the steps of “receiving, at the client system, input from a user indicating that the user has identified an electronic document as a prior art reference, the electronic document comprising a set of IDS information for identifying the prior art reference to an official patent office,” “in response to the input, transmitting a signal from the client system, the signal indicating that the user has

identified the prior art reference,” and “receiving the signal at a server system comprising a database,” and claims 1 and 16 are believed to be allowable for at least these reasons.

Similarly, claims 27-30 each recite, inter alia, “instructions to receive, at the server computer system, a signal from a client system, the signal indicating that a user has identified an electronic document as a prior art reference, the electronic document comprising a set of IDS information for identifying the prior art reference to an official patent office.” Porcari fails to teach or suggest this element, and claims 27-30 are believed to be allowable for at least this additional reason.

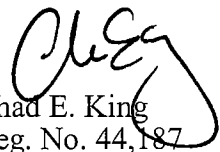
Accordingly, it is respectfully submitted that Porcari fails to teach or suggest each element of independent claims 1, 16 and 27-30, and that those claims, therefore, are allowable over Porcari. Dependent claims 3, 7-15, 18-23, 25 and 26 are believed to be allowable at least by virtue of their dependence from allowable base claims.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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